



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Patent Application of:

)Attorney Docket No.: F-190

Robert A. Cordery et al.

)Group Art Unit: 3621

Serial No.: 09/650,177

)Examiner: C. Hewitt II

Filed: August 29, 2000

)Date: July 31, 2003

Confirmation No.: 9743

Title: SECURE USER CERTIFICATE FOR ELECTRONIC COMMERCE EMPLOYING
VALUE METERING SYSTEM

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APPELLANT'S REPLY BRIEF TO EXAMINER'S ANSWER

Sir:

This Reply Brief, filed pursuant to 37 C.F.R. § 1.193, is in response to the Examiner's Answer mailed June 3, 2003.

(1) On page 4, the Examiner's Answer states, "In general, Appellant's arguments take an overly narrow view of the claim language, and grossly underestimate the level of knowledge of those of ordinary skill." The Examiner has not provided, however, any baseline that determines the level of ordinary skill in the art. The Federal Circuit has emphasized "the need to adhere to the statute, i.e., to hold that an invention would or would not have been obvious, as a whole, when it was made, to a person of 'ordinary skill in the art' - not to the judge, or to a layman, or to those skilled in remote arts, or to geniuses in the art." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F. 2d 693, 697, 218 USPQ 865, 868-69 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043,

224 USPQ 520 (1984). Without a determination of what constitutes “ordinary skill in the art,” the statement made in the Examiner’s Answer has no basis and is improper. Appellant respectfully maintains that without using the present claims as a road map, it would not been obvious to one of ordinary skill in the art to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references.

(2) On page 5, the Examiner’s Answer states, “Therefore, the only difference between the claimed invention and the combined prior art is a register having funds stored therein, determining if funds are present and deducting funds from the register for obtaining a certificate. (Appeal Brief, page 6, lines 23-27). However, this is clearly taught by Payne et al.” It should first be noted that there is no disclosure, teaching or suggestion in Payne et al. of obtaining a cryptographic certificate as in the present invention. Thus, these steps are not clearly taught by Payne et al.

In addition, it is not correct for the Examiner merely to focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves or individually would have been obvious. The claimed invention as a whole is to be considered. It is further impermissible for the Examiner to use the application itself as the basis or reasoning for formulating the obviousness rejection. As stated by the Federal Circuit, “It is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated the ‘[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’” *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F. 2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)). Without using the present claims as a road map, it would not have been obvious to make the multiple, selective modifications needed to arrive at the claimed invention from the cited references.

(3) On page 6, the Examiner’s Answer states, “The Examiner would also like to point out that what is being obtained, i.e., the certificate, is non-functional data, as it is not functionally related to the substrate of the article of manufacture (*In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir.

1994)).” The Examiner’s Answer provided no further explanation of the relevance of these cases or how they apply to the current claims at issue. The invention in *In re Gulack* was directed to an endless band upon which a plurality of individual digits were imprinted at regularly spaced intervals. In a 35 U.S.C. § 103 rejection, the Examiner found no relationship between the digits and band except that the band is the surface on which the digits are printed, and gave no patentable weight to the digits. In affirming the 103 rejection, the Board concluded the sole difference between the structure as claimed by the appellant (*Gulack*) and the prior art is in the content of the printed matter. Since there was no functional relationship of the printed material to the substrate, there was no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter. The Court of Appeals, in reversing the Board’s decision, found that the differences between the appealed claims and the prior art reside in the particular sequence of the digits, and the derivation of that sequence of digits.

In re Gulack, therefore, relates to printed matter and the substrate on which it is printed. It is not clear to Appellant how *In re Gulack* applies to the present claims at issue. There is no printed matter on a substrate in the present invention; accordingly, there is no claim being made that the basis for patentability is a difference in printed matter on a substrate.

The Examiner further appears to be confusing the terms “non-functional” and “no functional relationship.” There is no mention in *In re Gulack* of “non-functional data,” as *In re Gulack* is not directed to any type of “non-functional data”, i.e., data that has no function, but is instead directed to the absence of a functional relationship between printed matter and the substrate on which it is printed. The Examiner contends that the certificate recited in the claims at issue is “non-functional data” as is it not functionally related to the substrate of the article of manufacture. This statement simply does not make any sense. First, the statement that a cryptographic certificate is non-functional data is simply incorrect. A cryptographic certificate is indeed functional data, as it provides security services such as, for example, message integrity, message authentication, message confidentiality, and message non-repudiation. Further, the Examiner appears to be equating a cryptographic certificate with printed matter. A cryptographic certificate is in no way analogous to the printed matter in *In re Gulack*. Additionally, the claims of the present application are in no way directed to or even remotely related to a substrate having printed matter thereon. There is no substrate of an article of

manufacture claimed in the present invention. The claims at issue are not directed to an article of manufacture, but instead to a method for obtaining a cryptographic certificate.

The Examiner is misinterpreting the facts and holding of *In re Gulack*, and then misapplying the incorrect facts and holding to the claims at issue. There does not appear to be any legal or factual basis for the inclusion of these case cites or accompanying statements by the Examiner, as they have no bearing on the claims at issue.

(4) On page 6, the Examiner's Answer states, "Regarding claim 36, the Appellant has once again attempted to differentiate the Appellant's system from the combined prior art by relying on features not recited in the claims." Appellant's respectfully note that claim 36 is dependent upon claim 35. A dependent claims contains every limitation of the claim from which it depends. Thus, claim 36 does in fact include the features relied upon. The Examiner's Answer with respect to claim 36 is, therefore, devoid of any legal or factual premise.

In conclusion, at least for the reasons stated above and those provided in Appellant's Brief, Appellant respectfully maintains that the final rejection of claims 35 and 36 is in error and should, therefore, be reversed.

Respectfully submitted,



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